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09/899,378	07/02/2001	Scott Patrick Alcott	8285-422	9034

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EXAMINER

FOSTER, ROLAND G

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 03/01/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,378

Applicant(s)

ALCOTT, SCOTT PATRICK

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25, 27-32, and 34-38 is/are rejected.
- 7) ☒ Claim(s) 26 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 as follows: an application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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Claim 38 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,324,273 B1. This is a double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-17, and 19-25, 27-32, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,181,787 B1 to Malik (Hereafter "Malik") in view of U.S. Patent No. 5,465,295 to Furman (Hereafter "Furman").

With respect to claim 1, see the following paragraphs for details on how Malik discloses particular limitations within the claim.

The limitation "initiating a telecommunication network trigger based upon a service code dialed from an originating party" reads on the abstract, col. 13, lines 29-45 and col. 13, line 60 – col. 14, line 15 where a "public office feature code trigger (POFC)" is initiated in response to a feature access code dialed by the calling party. The access code comprises an asterisk followed by two digits (e.g., "*XX") (Id.)

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The limitation "initially establishing a subscription to the telecommunication service for the originating party in dependence upon the telecommunication network trigger" reads on the abstract, Fig. 2, col. 6, lines 46-67, and col. 11, lines 38-63 where a rental agreement (subscription) to a "temporary advanced telecommunication service" is initially established for the calling party in dependence upon the network trigger. Note that one specific example of the service provided is voice mail (col. 13, lines 7-21).

Although Malik discloses that the service code is in the form of "*XX" where the "XX" are dialed numbers that correspond to letters on a standard telephone keypad, Malik fails to specifically disclose that the "XX" service code includes an "alphabetical abbreviation for a name of the telecommunication service."

However, Furman (similarly to Malik) teaches of a system that activates a telephone network services such as voice mail in response to a dialed service code (Fig. 2 and col. 1, lines 25-60) where the service codes include alphabetical abbreviations for the name of the service (e.g., "VM" for "voice mail" and "*M" for messaging) (Fig. 2, col. 3, lines 49-58, and col. 4, lines 54-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a service code that is an alphabetical abbreviation for a name of the telecommunication service to be activated (e.g., "VM" for voice mail and "M" for messaging) as taught by Furman (a system that activates network services such as voice mail in response to a

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dialed service code) to the "XX" service codes disclosed by Malik (which is also a system that activates network services such as voice mail in response to a dialed service code).

The suggestion/motivation for doing so would have been increase the user-friendliness and accuracy involved in activating a telephone network services by relying on pneumatic aids such as activating a service by dialing the alphabetic abbreviation corresponding to the service which are easier to remember than the underlying telephone numbers themselves (Furman, col. 1, lines 20-46). Further, it would have been notoriously well known in the art to one of ordinary skill that standard telephone keypads (and even old rotary dialers) comprise letters that provide a pneumatic aid when dialing numbers. For example, dialed telephone numbers would have been known to correspond to the name or abbreviation of the service provided (e.g., 1-800-CALL-ATT, 1-800-FLOWERS, etc.).

Claims 12 and 23 differ substantively from claim 1 in that claims 12 and 23 are directed to a system and a computer readable medium that perform functions equivalent to the method steps of claim 1. Therefore, see the claim 1 rejection for further details. The "processor" reads on Malik, Fig. 3 where advanced intelligent network (AIN) computer based switches and devices such as the service control point (SCP) rely on a computer processor. The "computer-readable storage medium" and "data" stored therein read on the computer programs executed by the AIN computer based services.

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With respect to claim 24, see the following paragraphs for details on how Malik discloses particular limitations within the claim.

The limitation "initiating a telecommunications network trigger based upon a menu code dialed from an originating party" reads on col. 17, lines 14-43 where the service code may initiate a telecommunications network trigger (as discussed in the claim 1 rejection above) resulting in a menu of telecommunication "service options" that are provided to the caller. Therefore, the service activation code is a menu code.

The limitation "providing a menu of a of a plurality of telecommunications options corresponding to telecommunications network services, the menu provided in response to the telecommunications network trigger" reads on providing a menu of telecommunication options in response to the trigger as discussed above. The options also correspond to the specific services offered such as specific options for call forwarding (col. 17, lines 14-43).

Although Malik discloses a menu service and the corresponding "menu" service code as discussed above, Malik fails to specifically disclose that the menu code includes "at least one of "*M" and "#M".

However, Furman teaches that a service code can include a "*M" and this would have been an obvious addition to the "menu" service code as discussed in the claim 1 rejection.

The suggestion/motivation for doing so would have been for the same reasons as discussed in the claim 1 rejection above. In addition, the combination of Malik in view of Furman discloses dialing alphabetic abbreviations corresponding to various supported services. The actual choice of the specific abbreviation for the supported service thus goes to the non-structural content of the abbreviation. For example, Malik as modified discloses the capability (i.e., no structural modification is required) to use any type of alphabetic abbreviation such as *M corresponding to a supported menu service (as discussed above). Further, the telephone keypads contain all the letters of the alphabet and are capable of spelling out any particular abbreviation such as *M chosen for the supported menu service. A recitation of the intended use (e.g., the specific content used for service code such as an abbreviation) in the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). In this way, owners of the patented prior art devices are protected when using their devices without modification as they see fit. Here, the prior art structure of Malik in view of Furman is able to perform the intended use of using a specific type of alphabetic abbreviation (e.g., "*M") for the service code corresponding to the supported menu service. Therefore, Malik in view of Furman meets the claim requirements.

Claims 30 and 37 differ substantively from claim 24 in that claims 30 and 37 are directed to a system and computer-readable medium for performing functions equivalent to the method

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steps of claim 24. Therefore, see the claim 24 rejection for further details. In addition, "network element" reads on Malik, Fig. 3, service circuit node 36. The service circuit node 36 is also a AIN, computer based network switch. Thus, "computer-readable storage medium" and "data" stored therein are read by the computer programs executed by the computer of node 36.

With respect to claims 2, 3, 5, 13, 14, 16, 25, 29, 32 and 36, see the claim 1 rejection for further details.

With respect to claims 4 and 15, see the claim 24 rejection for further details regarding the obviousness of using a "*" to precede each digit as this modification goes to intended use (specific content). That is, Malik as modified discloses the capability (i.e., no structural modification is required) to use any sort of alphabetic abbreviation corresponding to the service provided.

With respect to claims 6 and 17, Malik discloses providing a caller identification service (col. 13, lines 15-20). See the claim 4 rejection regarding the obviousness of using the specific alphabetic abbreviation "ci".

With respect to claims 8 and 19, see Malik, col. 18, lines 3-28.

With respect to claims 9, 10, 20, and 21, see Malik, col. 9, lines 18-42 and col. 16, lines 1-67, and col. 21, lines 14-63.

With respect to claims 11 and 22, see Malik, col. 17, lines 20-30 where the service options triggered in response to the new service can be presented via a data or video interaction (correspondence) with the caller. The data or video correspondence with the caller is a "written" correspondence because the service option data is written, such as to the screen during the video interaction. See also col. 2, lines 38-62 where caller is also billed (written correspondence) for the service. Regarding "confirmation" of the service, see Fig. 2, step 17 and col. 11, lines 54-63.

With respect to claims 27 and 34, see the claim 24 rejection for further details.

With respect to claims 28 and 35, see Malik, col. 13, lines 18-21.

With respect to claim 31, see Fig. 3, service circuit node 36 which is a peripheral device in the intelligent (i.e., AIN) network 21.

Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik in view of Furman as applied to claims 1, 3, 12, and 14 above, and further in view of U.S. Patent No. 5,745,553 to Mirville et al. (Hereafter "Mirville").

With respect to claims 7 and 18, Furman as modified does not disclose, by Mirville teaches of call waiting service activated in response to a dialed access code (Fig. 4 "Call Waiting *9" and Fig. 11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the caller waiting service in response to a dialed access code as taught by Mirville to the service method and system activated by dialed access codes disclosed by Furman in view of Garland.

The suggestion/motivation for doing so would have been increase user-friendliness and flexibility by allowing the called party to have an indication of, and to respond to, an incoming call when the called party is engaged in another conversation on the telephone, as is extremely well-known in the art of telephone call waiting services.

See the claim 4 rejection regarding the obviousness of using the specific alphabetic abbreviation "cw" for the service code corresponding to a supported call waiting service.

Allowable Subject Matter

Claims 26 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 38 would be allowed notwithstanding the double patenting rejection set forth above.

Examiner's Reasons for Indicating Allowable Subject Matter

Claims 26 and 33 are directed to a narrowly ordered list of nine specific telecommunication options.

The closest prior art of record is Malik as discussed above. Malik fails to disclose the ordered list of nine options.

The remaining prior art of record fails to teach or fairly suggest substantially modifying Malik in order to support an ordered list of nine specific telecommunication options in order to arrive at the invention as narrowly claimed by the applicant.

Claim 38 is a substantial duplicate of claim 1 as set forth in parent case 09/044,618, now U.S. Patent No. 6,324,273 B1 (see the double patenting rejection above). Therefore, see the parent case for further details regarding the examiner's reasons for indicating allowable subject matter notwithstanding the double patenting rejection.

The above reasons for allowance are based on the claims as presently set forth in their totality. The above reasons for allowance should not be interpreted as indicating that amended claims broadly reciting certain limitations discussed in the above reasons for allowance would be allowable. A more detailed reasons for allowance may be set forth in a subsequent Notice of Allowance if and when all claims in the application are put into a condition for allowance.

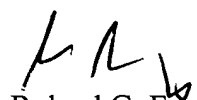
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.


Roland G. Foster
Primary Patent Examiner
February 21, 2004